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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,857	09/24/2003	Carl F. Miles	684.04	4404

7590 10/06/2004
Richard C. Conover
P. O. Box 1329
Bozeman, MT 59771

EXAMINER

LUBY, MATTHEW D

ART UNIT PAPER NUMBER

3611

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,857

Applicant(s)

MILES, CARL F.

Examiner

Matt Luby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 16 is unreadable. This apparent color photograph is un-
visible when it was scanned. Applicant is advised to employ the services of a competent
patent draftsman outside the Office, as the U.S. Patent and Trademark Office no
longer prepares new drawings. The corrected drawings are required in reply to the
Office action to avoid abandonment of the application. The requirement for corrected
drawings will not be held in abeyance.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*
Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection
based upon 35 U.S.C. 101.

Claims 1-7 are rejected under 35 U.S.C. 101 as claiming the same invention as
that of claims 1-7 of prior U.S. Patent No. 6,626,448. This is a double patenting
rejection.

Allowable Subject Matter

3. Claims 8-14 are allowed.

The prior art fails to disclose a motorcycle and exhaust pipe protector for a user of a motorcycle comprising: a motorcycle which is movable in fore-and-aft directions; a user footrest mounted to the motorcycle and extending in a lateral direction away from the motorcycle; an engine exhaust pipe on said motorcycle extending adjacent the footrest and further extending in the aft direction behind the footrest; an elongate rod; and means for mounting the rod to the motorcycle at a position between the footrest and the motorcycle and at an elevation above the footrest; the rod positioned to extend longitudinally in the fore-and-aft direction.

The prior art also fails to disclose A motorcycle and exhaust pipe protector for a user of a motorcycle comprising: a motorcycle which is movable in fore-and-aft directions; a user footrest mounted to the motorcycle and extending a lateral direction away from the motorcycle; an engine exhaust pipe on said motorcycle extending adjacent the footrest and further extending in the aft direction behind the footrest; an elongate rod; a bracket for mounting the rod to the footrest at a position between the footrest and the motorcycle and at an elevation above the footrest; the rod positioned to extend longitudinally in the fore-and-aft direction; the rod having a bent aft portion, bent in a vertical direction substantially orthogonal to the fore-and-aft direction; and the bent aft portion positioned directly aft of the footrest.

The prior art further fails to disclose a motorcycle and exhaust pipe protector for a user of a motorcycle comprising: a motorcycle which is movable in fore-and-aft

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directions; the motorcycle having a frame; a user footboard extending in a lateral direction away from the motorcycle; a footboard bracket for mounting the footboard to the motorcycle; a bolt for mounting the footboard bracket to the frame of the motorcycle; said motorcycle extending adjacent the footboard further extending in the aft direction behind the footrest; an engine exhaust pipe on an elongate rod having a longitudinal axis; a bracket for mounting the rod to the frame of the motorcycle; the bracket having a depending leg portion having one end joined to the elongate rod in depending relation and a tubular member mounted to a distal end of the leg portion and extending in direction orthogonal to the longitudinal axis of the elongate rod; the tubular member having an internal bore for receiving the bolt used for mounting the footboard bracket to the frame of the motorcycle; the rod positioned to extend longitudinally in the fore-and-aft directions; the rod having a bent aft portion bent away from the motorcycle in a lateral direction fore-and-aft direction; and substantially orthogonal to the bent aft portion positioned directly aft of the footboard.

The prior art still further fails to disclose a motorcycle and exhaust pipe protector for a user of a motorcycle comprising: a motorcycle which is movable in a fore-and-aft direction; the motorcycle having a frame; a user foot peg extending in a lateral direction away from the motorcycle; a foot peg mounting bracket secured to the frame of the motorcycle; a bolt for mounting the foot peg to the foot peg mounting bracket; an engine exhaust pipe on said motorcycle extending adjacent the foot peg for extending in the aft direction behind the foot peg; an elongate rod having a longitudinal axis; a protector bracket for mounting the elongate rod to the foot peg bracket; the protector bracket.

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having a bore there through for receiving the bolt mounting the foot peg to the foot peg bracket and further having a second bore for receiving one end of the elongate rod; the elongate rod the second bore; positioned with a forward end located in the protector bracket further having a set screw for frictionally engaging the elongate rod to secure the elongate rod at a selected rotated position within the second hole; the rod having a bent fore portion bent back on itself in a vertical direction and extending in the aft direction; and the elongate rod located at a position between the foot peg and the motorcycle, and at an elevation above the foot peg.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (703) 305-0441. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matt Luby
Examiner
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A handwritten signature in black ink, appearing to read "Matt Luby", written in a cursive style.

M.I.
September 30, 2004